

R E M A R K S

Claims 8, 16-18, and 23-32 are pending in this application. Claims 8, 11, 16-18 and 21-32 have been rejected and claims 9, 10 and 12-15 are withdrawn from consideration. No new matter has been added by way of the above amendments. For instance, claims 9-15, 21 and 22 have been canceled and claims 8, 23 and 24 have been amended to recite one or more symptoms as supported by the present specification at page 11, line 16 to page 12, line 12. Accordingly, no new matter has been added. Additionally, no new issues have been raised by way of the present submission, which would require additional search and/or consideration on the part of the Examiner.

In the event that the present submission does not place the application into condition for allowance, entry thereof is respectfully requested as placing the application into better condition for appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all the rejections and allow the currently pending claims.

Improper Finality

In the outstanding Office Action, the Examiner has added an additional reference, in particular, the definition of "stress" has been supplemented from Dorland's illustrated medical dictionary. Please refer to page 3, last paragraph of the outstanding Office Action. In this regard, Applicants assert that the Examiner has, for the first time, utilized this reference. This is improper and denies Applicants the opportunity to respond to this new reference on the merits. Accordingly, the Examiner is respectfully requested to withdraw the finality of the outstanding Office Action.

Issues under 35 U.S.C. 103(a)

The Examiner has rejected claims 8, 11, 16-18 and 21-32 as being obvious over Fuji et al., JP 406100442 (hereinafter referred to as Fuji '442) in view of the Merck Manual (fifteenth edition). Applicants respectfully traverse this rejection.

The Examiner asserts that one of ordinary skill in the art understands that an anti-stress composition, as disclosed in Fuji

'442 was known, thus, one would have motivation to use that anti-stress composition to treat a PMS patient who was in need of suppression of stress. Applicants disagree with this rejection.

Applicants note that the present claims relate to the treatment of one or more symptoms in an individual. The symptoms are specifically recited in the independent claims and include sleepiness, fatigability, stiff breasts, painful breasts, likelihood to have acne, chapped skin, bad spread of cosmetics, increased vaginal discharge, inability to take smooth body action, allergic symptoms, headache, head stuffiness, stiff shoulders, vertigo, limb coldness, abdominal pain, lower abdominal pain, lower abdominal stiffness, lumbago, swelling, thirst, constipation, diarrhea, food preference change, spiritlessness, aggressiveness, faintheartedness, maudlinness, solitariness, loneliness, psychological lift, increased sexual desire, autism, mysophobia, inability to manage one's health, repugnance to menstruation, repugnance to being female, craving to be alone and unsociableness. Applicants note that these symptoms, although associated with PMS, do not include stress. In this manner, the present claims do not involve the treatment of stress. Based upon the present claims, Applicants respectfully submit that the prior art fails to suggest or disclose the use of theanine as currently claimed for the treatment of one or more of these

symptoms. Accordingly, the Examiner has failed to present a valid *prima facie* case of obviousness.

Applicants further point out that the Examiner's rationale in the outstanding rejection is flawed. The Examiner continues to maintain that an anti-stress composition is known for treating disorders having stress as a symptom, however, based on this rationale, the Examiner would be able to reject any condition having stress as a symptom. This is incorrect and illustrative of the incorrectness of the Examiner's *prima facie* case of obviousness.

Each of the presently claimed symptoms can be effectively suppressed or ameliorated according to the present invention. In this regard, the Examiner is respectfully requested to refer to the results of Test Examples 5-7.

In summary, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicants respectfully petition for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$110.00 is attached hereto.


Appl. No. 09/655,336

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Craig McRobbie (Reg. No. 42,874) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment